

'463 application is supposed to render canceled claim 14 (and corresponding claim 29) of the instant application invalid under § 101, or the way in which the elements in those claims are supposed to correspond to the elements in claim 29. Furthermore, claims 1-4 of the '463 application have been canceled and independent claims 5 and 6 of the '463 application have been amended. In addition, claim 29 of the instant application has been amended. Claim 29 as amended is clearly not directed to the "same invention" as the claims of the '463 application. In addition, claim 29 would not be obvious in view of any of the claims of the '463 application. Applicants therefore respectfully request that the Examiner withdraw the rejection of statutory double patenting.

Nonstatutory Double Patenting

A. The Examiner has provisionally rejected claims 1-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 15-16 of copending Application No. 09/535,854. The examiner has stated that "Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, drawn to a method of detecting a target nucleic acid, are a genus of the '854 claims which are drawn to a method of determining the identification of a nucleotide at a detection position in a target sequence and a genus is obvious over the species."

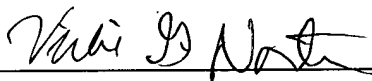
Applicants respectfully traverse this rejection. As an initial matter, no claims have been allowed in copending Application No. 09/535,854; therefore, as the Examiner notes, the rejection is merely provisional until claims issue in one of the applications. In addition, if one of the applications were to issue while the second application was still pending, any delay in the issuance of the second patent is not due to delays on the part of Applicant. Application Ser. No. 09/535,854 was filed on March 27, 2000, while the instant application was filed on April 20, 2000—merely 3 days apart.

Claims 1-13 in the instant application have also been canceled, thereby rendering moot the rejection with respect to those claims. Claim 14 has also been canceled, with new claim 29 corresponding to claim 14 as amended. Applicants respectfully assert the cancellation and/or amendment of claims 1-14 in the instant application have rendered the rejection on the basis of non-statutory double patenting moot, and respectfully request that the rejection be withdrawn..

B. The Examiner has provisionally rejected claims 1-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 09/513,362. The Examiner has asserted that "although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, drawn to a method of detecting a target nucleic acid, are a genus of the '362 claims which are drawn to a method of sequencing a target sequence wherein both sets of claims comprise similar method steps. The genus is obvious over the species and therefore, the instant claims are obvious over the '362 claims." 5/30/03 Office Action. As an initial matter, the claims of the '362 application have been amended since the Examiner made the obviousness-type double patenting rejection. In addition, claims 1-13 of the instant application have been cancelled, and claim 14 has been amended, thereby mooting the rejection. Applicants therefore respectfully request that the Examiner withdraw the rejection of nonstatutory double patenting in view of the '362 application.

Respectfully submitted,

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